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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/262,628	03/04/1999	JEROLD S. HORN	52075USA5A	9693

7590 02/19/2002

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EXAMINER

ZITOMER, FRED

ART UNIT	PAPER NUMBER
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1713

13

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-13

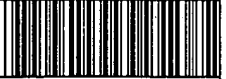
# **Advisory Action**

Application No.  
**09/262,628**

Applicant(s)  
**Horn et al.**

Examiner  
**Fred Zitomer**

Art Unit  
**1713**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: 0  
Claim(s) objected to: 0  
Claim(s) rejected: 1-4, 7, 8, 10, and 12-23
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: See ATTACHMENT and Form PTO-892.

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### ATTACHMENT

Applicant's arguments filed January 29, 2002 have been fully considered but they are not persuasive.

The assertion that claims 17-19 feature a Markush group containing seven specific fluoroplastics is incorrect for at least the following reasons:

- the language of claim 17 is not Markush language. Proper Markush group language recites "selected from the group consisting of A, B, C and D.". MPEP 2173.05(h).
- with the possible exceptions of two homopolymers, poly(vinylidene fluoride) and poly(vinyl fluoride), the fluoroplastics claimed are recited in generic form. For example, terminology such as perfluoroalkoxyethylene and ethylene-chlorotrifluoroethylene encompasses a genus of copolymers comprising a multiplicity of alkoxygroups and/or ratios of comonomer units.
- Hammar teaches fluoroelastomers in generic form [column 5, line 59], gives some examples of said elastomers [column 5, lines 61-67] and then cites various U.S. patents which disclose species of said elastomers [column 6, lines 26-28]. The following patents cited by Hammar clearly disclose polymers of instant claim 17:

- US 4,882,390, column 2, line 55 - column 3, line 29.
- US 3,712,877, paragraph bridging columns 1 and 2; column 3, lines 41-72.
- US 4,035,565, column 1, line 37 et seq.

Clearly the generic and specific fluoroelastomer disclosed by Hammar are commensurate with instant claim 17.

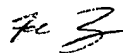
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The assertion that applicant need not define terms that have a well recognized meaning is not understood. Applicant created the issue by substituting "fluoroplastic" in the original claims for "fluoropolymeric" in Paper No. 10. Applicant then stated that the claims were thus further limited and that the term is supported in the Background section of the present application [Paper No. 10, REMARKS]. However, contrary to the assertion "fluoroplastic" is not used in the present application. Further, it is not clear how the term further distinguishes the present polymers from those of Hammar. The assertion that "...these rejections are premised upon the Examiner's mistaken belief that the terms "fluoropolymer", "fluoroplastic" and "fluoroelastomer" are somehow interchangeable and describe the same polymers." is at variance with the facts. The issue here is not the definition of terms or their equivalence. The issue is the difference in the term as perceived by applicant and where the alleged difference is enabled in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



FRED ZITOMER, PhD  
PRIMARY EXAMINER  
ART UNIT 1713

Zitomer/fz  
February 8, 2002